

REMARKS

Claims 15, 18-20, 22, 26-27, 30-39, 42, and 44-52 are currently pending in the application. Claim 15 has been amended and claim 17 has been cancelled. Applicants note with appreciation the indication by the Examiner that claims 30-39, 42, 44, 45, 50, and 51 are allowable over the prior art of record.

Because the proposed amendments were denied entry by the Examiner in her Advisory Action mailed on October 8, 2004, the amendments to the claims are again being submitted for consideration. Applicants have also amended the “Related Applications” section of the specification to replace all previous versions so that the correct chain of priority is clearly demonstrated.

Benefits of Filing Date of Prior Applications Issue

Applicants agree with the chronology with respect to this issue set forth on pages 2 through 9 of the Examiner’s office action.

The Examiner maintains that Applicants have failed to show that the August 13, 2004 amendment corrected the benefit claim to prior applications 08/479,339 and 08/082,689 because of the incorrect relationship in the Amendment of August 13, 2001 with respect to 08/905,654 being referenced as a division of 08/479,339 instead of the actual relationship of 08/905,654 as a continuation of 08/479,339 and that the Amendment of August 13, 2001 is thus not in correct form to obtain benefit of the filing date beyond that of 08/905,654 if a corrected filing receipt had been issued.

Applicants have cancelled all previous version of the cross-reference to related applications and concurrently herein are submitting the following:

“This application is a divisional of Application Serial No. 08/905,654 filed 8/4/97, which is a file wrapper continuation of

08/479,339, filed 6/7/95, which is a continuation in part of 08/082,689, filed 6/25/93.”

At the time of filing of the instant application, as reproduced by the Examiner on page 2 of her Office Action, the cross-reference to related applications language was amended in a concurrently filed Preliminary Amendment as follows: “This Application is a divisional of Application Serial No. 08/905,654, filed 8/4/97, which is a file wrapper continuation of 08/479,337 filed 6/7/95 which is a continuation in part of 08/082,689 filed 6/25/93, the contents of each of which are hereby included by reference in their entirety.” As noted by the Examiner, 08/479,337 inadvertently contains a typographical error, and should instead have referenced 08/479,339. This typographical error was timely corrected in an amendment filed on August 13, 2001. As noted by the Examiner, this amendment of August 13, 2001 introduced the new error of referred to 08/905,654 being a divisional of 08/479,339 instead of a file wrapper continuation.

It is believed that language submitted by Applicants concurrently herein in the present amendment is fully supported by the application as originally filed and thus contains no new matter. The language submitted by Applicants is virtually the same as the language of the preliminary amendment with the correction of the typographical error in 08/479,339. Thus Applicants believe that this amendment addresses the concerns noted by the Examiner and is sufficient to demonstrate priority for the pending claims of the application as of the date of the 08/082,689 application filed June 25, 1993. This statement also does not recite that the prior applications are incorporated by reference, which the Examiner indicated in her office action would be considered new matter.

In her interview summary of the telephone interview held on August 24, 2004, the Examiner noted that there could be some issue as to the support of all of the claims of record all the way back to the original Serial No. 08/082,689 that could leave Fan available for a reference. Applicants have reviewed the disclosures of the originally filed 08/082,689 application and the disclosure of the instant application, which is a

continuation-in-part of the 08/082,689 application. Applicant believes that the claims presented in the instant application are fully supported by the 08/082,689 application and thus have an effective date as of the filing date of this application. The 08/479,339 application, which is a continuation-in-part of the 08/082,689 application, contains the same disclosure as 08/905,654 which is a file wrapper continuation of the 08/479,339 application and the same disclosure as the instant application, which is a division of the 08/905,654 application. The continuation-in-part application provides a substantially similar disclosure to that of the 08/082,689 application, but adds further disclosure to a second photocurable (or overcoat layer) (See the specification, page 2, lines 10-32 and page 12, line 7 through line 13, line 3.) The claims in the instant application do not provide a limitation for the second overcoat layer and are therefore believed to be afforded the effective filing date of the 08/082,689 application – June 25, 1993. Thus Applicants respectfully submit that the claims are fully supported by the 08/082,689 application and the Fan reference is not prior art for any of the pending claims of the instant application.

Declaration of Kanga

The Examiner did not consider the new Declaration of Kanga because of the change in wording in replacing “photopolymerizable” with “photocurable.” The Examiner asserts that because of this change, she considered the new Declaration not to address issues solely brought upon in the final rejection.

Applicant respectfully disagrees. The language pointed out by the Examiner as being objectionable is the same language as contained in the present version claim 15. The previous declaration (a complete copy of which was filed on August 7, 2003 and refilled on March 5, 2004) referred to the version of claim 15 that was amended in Applicants’ response filed on August 7, 2003. In reviewing the Declaration of Kanga so as to refer to pages in a single exhibit instead of to Exhibits A-G, Applicants noticed that the language on page 6 of the Declaration of Kanga that referred to claim 15 had not been updated to correspond to the most current version of claim 15. Applicants believed that it

would be prudent to update the Declaration of Kanga to refer to the current version of Claim 15 and did not believe that the Examiner would object to the replacement of “photopolymerizable material” with “photocurable layer” or to refer to ultraviolet radiation, which is the only other change that is present in the revised Declaration of Kanga submitted for consideration on September 22, 2004. However in moving this application more quickly to issue, Applicants are resubmitting the Declaration along with a Request for Continued Examination. Applicants respectfully request that the Examiner consider the enclosed revised Declaration of Kanga, which is a copy of the revised Declaration of Kanga previously submitted on September 22, 2004.

35 U.S.C. §102(e)/35 U.S.C. §103(a) rejection

Claims 15, 17-20, 22, 26-27, 46-49, and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Fan (6,238,837). The Examiner maintains that Fan has a filing date of May 1, 1995 which is before the oldest effective filing date of the instant application, i.e., August 4, 1997 and that Fan is thus seen as prior art under 35 U.S.C. 102 (e).

As stated previously, it is Applicants’ belief that the effective filing date of this application is June 25, 1993 because priority was timely filed within the required time period. Therefore, Applicants respectfully submit that Fan is not available as patent art against the instant application because it does not have a filing date prior to June 25, 1993. Because Fan cannot be used as prior art against the claims of the instant application, Applicants respectfully request that the rejection of claims 15, 18-20, 22, 26-27, 46-49, and 52 under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Fan (6,238,837) be withdrawn.

35 U.S.C. §103 Rejection

Claim 15 stands rejected under 35 U.S.C. §103 as being unpatentable over Scott Paper Company in view of the Murphy Declaration and further in view of Law et al.

The Examiner states that in view of Mr. Murphy's expert opinion that the disclosure of one IR ablatable layer in the materials of the 1993 application as being sufficient to give support for the instant claims which have no binder in common with the disclosure of the sole IR ablatable material disclosed functional enough to form a working plate, than the disclosure of Scott Paper Company is sufficient to make obvious the use of any binders used in non-UV laser radiation ablatable layers known in the art before the 1993 disclosure as well as any ultraviolet lithographic negative acting presensitized plates known before the 1993 disclosure, because the predictability of the art at the filing of the 1993 disclosure is so predictable to allow such breadth of obviousness.

Applicant respectfully disagrees. Claim 15, as it is presently drafted, does in fact have a binder in common with the disclosure of the IR ablatable material "disclosed functional enough to form a working plate." Claim 15 and Example 3 of the application (page 17, lines 27+ of the specification) both provide for the use of polyamide as a binder of the laser ablatable layer.

Claim 15 has also been amended in the present response to specifically refer to a photosensitive printing element and to include the limitation of cancelled claim 17, which claim was not included in the rejection of claim 15 over Scott Paper Company in view of the Murphy declaration and Law et al.. Claim 15 was also amended in the previous response (mailed on March 5, 2004) to change "photopolymerizable" to "photocurable" and to change "infrared radiation" to "laser radiation." Thus, instant claim 15 is not limited to infrared laser radiation as is inferred by the Examiner, but is open to other wavelengths of laser radiation. Furthermore, the Decl. of Kanga explains that the June 1993 application does not require that a particular wavelength of radiation be used but repeatedly refers to ablation at a "selected wavelength" or at an "appropriate wavelength" (see Decl. of Kanga ¶8(a)). The Decl. of Kanga further explains that the June 1993 application provides examples using both UV laser radiation and infrared laser radiation

(see Decl. of Kanga ¶8(b)), i.e. an “appropriate wavelength” as demonstrated by the examples.

Applicant respectfully submits that Law et al. does not describe a photosensitive printing element but rather describes an optical recording composition wherein the ablative optical recording devices are exposed to laser light causing pits or holes to be formed in the absorbing layer, which information can be read in reflection by means of laser light. Furthermore, Law et al. does not teach or suggest a layer of a photocurable composition. While Law et al. does describe a laser ablatable layer, the laser ablatable layer of Law et al. is deposited on a reflective substrate, such as a reflective glass substrate (see column 6, lines 66-67) not on a layer of photocurable composition.

In addition, Mr. Murphy’s declaration is directed to a prior version of claim 15, which claim has been amended multiple times to distinguish the claimed invention over the prior art of record. Applicant respectfully submits that while Mr. Murphy’s declaration may demonstrate the breadth of obviousness as to previous versions of claim 15, the present version of claim 15 contains many features that were not contained in the prior version of the claim as discussed in the previous paragraphs and is thus distinguishable from the prior art of record.


For all of these reasons, it is believed that present claim 15 is not anticipated or rendered obvious by the prior art.

Conclusion

Applicant believes that the foregoing is a complete response to all of the objections and rejections raised by the Examiner and that all of the claims of the instant application are now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance is respectfully requested.

If the Examiner feels that a telephonic interview would be helpful, she is requested to contact the undersigned at (203) 575-2648.

Respectfully Submitted,



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